

Remarks

I. Status of the Application

Claims 1, 4-12, and 29-34 were previously pending. Claims 1, 4-12, and 29-34 were rejected by the Examiner. Claim 29 has been withdrawn without prejudice. Claims 1, 9, and 30 are currently amended. The amendments do not add new matter. In particular, the support for the claim amendments may be found throughout the specification and originally filed claims, as well as published paragraph [0010]. The Applicants respectfully request the Examiner to consider the following remarks in light of the newly amended claims. Upon entry of these amendments, claims 1, 4-12, and 30-34 will be pending and under active consideration.

II. Claim Rejections - 35 USC § 103

Claims 1, 4-12, and 29-34 have been rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,112,191 ("Burke") in view of U.S. Patent No. 6,164,533 ("Barton").

A. Claims 1 and 30

The Office Action states that, "Regarding claims 1 and 30, Burke discloses a method for effectuating an investment including completing a point-of-sale transaction by a user at a point-of-sale location using an electronic payment method associated with a purchasing or savings account, receiving by a computer a request to complete an on-demand investment transaction . . . after completion of the point-of-sale transaction . . . identifying by the computer investment preference information associated with the user in response to receiving the request wherein the preference information includes the purchasing or savings account, and causing by the computer

funds relating to the investment amount to be transferred from the purchasing or savings account to an investment account.” (Internal citations omitted). The Office Action further states that, “The disclosure of Burke does not specifically teach that the investment preference information includes any predetermined monetary investment amount for the on-demand investment, as the investment amount in the method of Burke is specified at the point-of-sale location at the time of the sale.” However, the Office Action asserts that “[I]t would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to include in the investment-preference information a predetermined monetary investment amount for the on-demand investment, in accordance with the teachings of Barton, in order to assist a user in achieving a budgeted investment goal by suggesting a default investment amount with each purchase being made.” (Emphasis Added).

The Applicants rebut the above § 103 rejection with the attached 37 C.F.R. §1.132 declaration as hard evidence showing why one of skill in the art would have no motivation and/or no expectation of success in modifying the Burke patent or combining it with other patents in order to arrived at the currently claimed invention. In view of the factual evidence in the declaration, the law indicates that the Burke ‘191 patent actually teaches away from the claimed invention because the proposed modification of the ‘191 patent would produce an inoperable and unacceptable device. “If references taken in combination would produce a ‘seemingly inoperative device,’ we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001).

The attached declaration also shows why each and every element of the claimed invention has not been taught by the cited art. Among other factors, the declaration states the factual basis why the Burke '191 patent does not teach the claimed elements of "an on-demand investment" or a "purchase or savings account linked to an investment account." To support a finding of obviousness, "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Here, the attached §1.132 declaration refutes the factual basis relied upon in the Office Action, and shows why the currently claimed invention would be non-obvious to one of skill in the art at the time of filing.

In view of the foregoing, the Applicants respectfully traverse this basis for rejection of claims 1 and 30 and request its reconsideration and withdrawal. Thus, the Applicants respectfully request withdrawal of the obviousness rejections of these claims and seek allowance of pending claims 1, 4-12, and 30-34.

B. Claim 4

Regarding claim 4, the Office Action states that "Burke further comprises the step of temporarily accumulating the on-demand investment requests until a predetermined completion time. See, in particular, column 3, lines 4-13."

The Burke specification, however, makes clear that the cited transactions are not on-demand investment requests, but rather overpayments from the customer to the merchant. The following excerpt later in the column 3 of the Burke patent shows that the patent disclosure is actually referring to a different type of transaction – namely, a cash overpayment by the customer, rather than an on-demand investment.

"For example, Sears may enroll a subscriber *consumer in a Sears store* account allowing the consumer to use their Sears issued mag stripe card to identify them when they *deposit excess change* into any *merchant/collector terminal*. In this capacity Sears is playing the role of a distinct provider in the network. The card may be used to deposit excess funds in restaurants, convenient stores, other department stores, etc." (See Burke, col. 3, lines 49-58).
(Emphasis Added).

In view of the above passage, it is evident there is no accumulation of "on-demand investment requests" as currently claimed, but only a surplus account held by the service provider at Level 3. For example, Burke states at col. 4, lines 5-7, "*Level 3 assigns the funds to an account previously opened by Level 1 SP through services provided by Level 3.*" (Emphasis Added).

In view of the foregoing, the Applicants respectfully traverse this basis for rejection of claim 4 and request its reconsideration and withdrawal. The Applicants respectfully request withdrawal of the obviousness rejections of these claims and seek allowance of pending claims 1, 4-12, and 30-34.

C. Claims 5-8

The Office Action further states, "Regarding claims 5-8, Burke does not disclose any investment limit/maximum, thus does not disclose accommodating an investment limit/maximum by including an investment total and a predetermined investment limit in the investment-preference . . . However, Barton discloses a similar method of investment, which method indeed include contributing the on-demand investment request to an investment account

having a limit/maximum (an IRA). . . it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to invest in an account having an investment limit/maximum in accordance with the teachings of Barton . . ." (Emphasis Added).

As discussed above, the Applicants rebut the above § 103 rejection with the attached § 1.132 declaration as hard evidence showing why one of skill in the art would have no motivation and/or no expectation of success in modifying the Burke patent or combining it with other patents in order to arrived at the currently claimed invention. To support a finding of obviousness, "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Here, the attached § 1.132 declaration disproves the factual basis relied upon by the Office Action, and shows why Burke teaches away from the currently claimed invention at the time of filing.

In view of the foregoing, the Applicants respectfully traverse this basis for rejection of claims 5-8 and request its reconsideration and withdrawal. The Applicants respectfully request withdrawal of the obviousness rejections of these claims and seek allowance of pending claims 1, 4-12, and 30-34.

D. Claims 9-11

The Office Action further states, "Regarding claims 9-11, the method of Burke comprises associating a purchasing account with an investment account . . . See, in particular, column 12, lines 11-15."

The Applicants respectfully disagree with this characterization of the Burke '191 patent. In fact, Burke does not associate a purchasing account with an investment account. The cited passage only refers to "excess funds from spending transactions" – there is no association between the purchasing account with an investment account. (Emphasis Added). This difference is also supported by the figures in Burke, including Figures 1B and 1D, which show that the excess funds are passed from the customer to the merchant and from the merchant to the processing network, such that there is plainly no direct association between the purchasing account with an investment account. (Emphasis Added).

In view of the foregoing, the Applicants respectfully traverse this basis for rejection of claims 9-11 and request its reconsideration and withdrawal. The Applicants respectfully request withdrawal of the obviousness rejections of these claims and seek allowance of pending claims 1, 4-12, and 30-34.

E. Claims 12 and 30-34

The Applicants note the Office Action's rejection of claims 12 and 30-34 with reference to "the combination described above with respect to claim 1."

As discussed above, the Applicants rebut the above § 103 rejection(s) with the attached § 1.132 declaration as hard evidence showing why one of skill in the art would have no motivation and/or no expectation of success in modifying the Burke patent or combining it with other patents in order to arrived at the currently claimed invention. To support a finding of obviousness, "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Here, the attached § 1.132 declaration rebuts the factual basis relied upon by the Office Action,

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and shows why the currently claimed invention would be non-obvious to one of skill in the art at the time of filing.

In view of the foregoing, the Applicants respectfully traverse this basis for rejection of claims 12 and 30-34 and request its reconsideration and withdrawal. The Applicants respectfully request withdrawal of the obviousness rejections of these claims and seek allowance of pending claims 1, 4-12, and 30-34.

III. Conclusion

The Applicants respectfully submit that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted

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